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EXAMINER

JOSEPH, TONYA S

ART UNIT PAPER NUMBER

3628

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/809,570

Applicant(s)

ALEXIA ET AL.

Examiner

Tonya Joseph

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of Claims***

Claims 19, 23, 25, 28-29 and 31 have been amended. Claims 32-44 have been added. No additional claims have been cancelled. Thus claims 19-44 are presented for Examination.

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 19-31 have been considered but are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine can be found in Strand which teaches, in order to provide for automated remote analyses, para. 6 lines 3.

2. Applicant's arguments with respect to claims 20-29 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 28-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The term "sufficiently flexible" "bend easily" and "sufficiently thin" in claims 28-29 are relative terms which render the claims indefinite. The terms sufficiently flexible" "bend easily" and "sufficiently thin is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For Examination purposes, Examiner is interpreting any circuit fixed to a print member as meeting the limitations of the claim.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 19-22, 24, 26-31 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pauschinger et al. U.S. patent No. 6,978,255 B1 in view of Pauschinger U.S. Patent No. 6,041,704 in further view of Strand U.S. Pre-Grant Publication No. 2002/0199094 A1.

7. As per Claims 19 and 31, Pauschinger et al. teaches a unit for generating franking data and a unit for printing data connected to said data generating unit and

adapted to receive franking data therefrom (see Col. 5 lines 54-61 and Col. 9 lines 47-52), said printing unit including at least one member for printing data (see Col. 6 lines 36-41), wherein the franking machine includes: means for obtaining data enabling identification and authentication of the print member by the data generating unit in a first communication mode (see Col. 6 lines 63-67; Col. 7 lines 1-2; 40-44 and Col. 4 lines 49-51), Pauschinger et al. does not explicitly teach means for generating a signature of the franking data by the data generating unit, means for encrypting the signature of the franking data by the data generating unit, means for sending the franking data and the encrypted signature to the printing unit in a second communication mode, Pauschinger teaches wherein the franking machine includes: means for generating a signature of the franking data by the data generating unit (see Col. 5 lines 3-8), means for encrypting the signature of the franking data by the data generating unit (see Col. 5 lines 36-40), means for sending the franking data and the encrypted signature to the printing unit in a second communication mode, (see Col. 7 lines 54-59). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Pauschinger et al to include the teachings of Pauschinger to allow for the verification of franking imprints as taught in Pauschinger Col. 5 lines 5-7. Pauschinger et al. teaches and means for decrypting the encrypted signature. Pauschinger et al does not explicitly teach decryption performed by the print member. Strand teaches, The conduit cartridge encrypts information sent to an analytical system or an operating facility in communication with the conduit cartridge and can decrypt encrypted information received from an analytical system or an operating facility (see The Abstract of Strand).

It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Pauschinger et al. and Pauschinger to include the teachings of Strand in order to provide for automated remote analyses, as taught in Strand para. 6 lines 3-4.

8. As per Claim 20, Pauschinger et al; Pauschinger and Strand teach the system of claim 1 as described above. Pauschinger et al. does not explicitly teach, wherein the print member includes means for authenticating data. Strand teaches the print member includes means for authenticating data (see para. 15 lines 29-34; 45-50; 53-54; 60-64 and para. 19 lines 4-20). Pauschinger et al. teaches franking data. It would have been prima facie obvious to one of ordinary skill in the art to modify the systems of Pauschinger et al. and Pauschinger to include the teachings of Strand in order to provide for automated remote analyses, as taught in Strand para. 6 lines 3-4.

9. As per Claim 21, Pauschinger et al; Pauschinger and Strand teach the system of claim 19 as described above. Pauschinger does not explicitly teach wherein the print member includes means for verifying the integrity of the franking data. Strand teaches wherein the print member includes means for verifying the integrity of the data (see para. 15 lines 29-34; 45-50; 53-54; 60-64 and para. 19 lines 4-20). Pauschinger et al. teaches franking data. It would have been prima facie obvious to one of ordinary skill in the art to modify the systems of Pauschinger et al. and Pauschinger to include the teachings of Strand in order to provide for automated remote analyses, as taught in Strand para. 6 lines 3-4.

10. As per Claim 22 and 44, Pauschinger et al; Pauschinger and Strand teach the system of claim 19 as described above. Pauschinger does not explicitly teach wherein the print member includes at least one tag identifying said print member. Strand teaches wherein the print member includes at least one tag identifying said print member (see para. 12 lines 6-10). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Pauschinger et al and Pauschinger to include the teachings of Strand to aid in the identification of the cartridge. The limitation, "communicates data identifying said member to the data generating unit by radio waves when an electromagnetic field is applied to it"; "such that attempting to remove the tag will render it inoperative is merely a statement of intended result and as such is afforded little patentable weight.

11. As per Claim 24, Pauschinger et al; Pauschinger and Strand teach the system of claim 19 as described above. Pauschinger et al. further teaches, wherein the data-generating unit includes a circuit for receiving identification data (see Col. 6 lines 63-67, Col. 7 lines 1-2 and 40-44, Examiner is interpreting meter able to recognize an identification code word as containing a circuit for receiving identification data).

12. As per Claim 26, Pauschinger et al; Pauschinger and Strand teach the system of claim 19 as described above. Pauschinger does not explicitly teach wherein the decrypting means of the print member have obtains data identifying said print member. Strand teaches wherein the decrypting means of the print member have knowledge of data identifying said print member (see para. 19 lines 34-44). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the

systems of Pauschinger et al. and Pauschinger to include the teachings of Strand in order to maintain data integrity, as taught in Strand para. 34-44.

13. As per Claim 27, Pauschinger et al; Pauschinger and Strand teach the system of claim 19 as described above. Pauschinger et al. does not explicitly teach wherein the print member includes a data processing unit that includes the decrypting means. Strand teaches wherein the print member includes a data processing unit that includes the decrypting means (see para.15 lines 60-64). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Pauschinger et al. and Pauschinger to include the teachings of Strand in order to decrypt transmitted information, as taught in Strand para. 60-69.

14. As per Claim 28, Pauschinger et al; Pauschinger and Strand teach the system of claim 19 as described above. Pauschinger et al; does not explicitly teach wherein the decrypting means are fixed to a printed circuit that is fixed to the print member, wherein the printed circuit is sufficiently flexible to bend easily and sufficiently thin to be installed on a standard inkjet printer cartridge without compromising installation of the cartridge in a standard inkjet printer associated with the cartridge Strand teaches wherein the decrypting means are fixed to a printed circuit that is fixed to the print member (see para. 18 and Fig. 3. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Pauschinger et al. and Pauschinger to include the teachings of Strand in order to verify information used by the cartridge, as taught in para. 17 lines 7-10. The limitation "printed" is considered non-functional descriptive material and as such is afforded no patentable weight.



15. As per Claim 29, Pauschinger et al; Pauschinger and Strand teach the system of claim 19 as described above. Pauschinger et al; does not explicitly teach wherein the data processing unit is fixed to a circuit that is fixed to the print member; wherein the printed circuit is sufficiently flexible to bend easily and sufficiently thin to be installed on a standard inkjet printer cartridge without compromising installation of the cartridge in a standard inkjet printer associated with the cartridge Strand teaches wherein the data processing unit is fixed to a circuit that is fixed to the print member (see para. 12 lines 6-20 and Fig. 3). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Pauschinger et al. and Pauschinger to include the teachings of Strand in order to verify information used by the cartridge, as taught in para. 17 lines 7-10. The limitation "printed" is considered non-functional descriptive material and as such is afforded no patentable weight.

16. As per Claim 30, Pauschinger et al; Pauschinger and Strand teach the system of claim 19 as described above. Pauschinger et al. further teaches wherein the print member is an inkjet printer cartridge including at least one print head (see Col. 6 lines 31-41).

17. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pauschinger et al. U.S. Patent No. 6,978,255 B1 in view of Pauschinger U.S. Patent No. 6,041,704 in further view of Strand U.S. Pre-Grant Publication No. 2002/0199094 A1; Official Notice and Chung U.S. Pre-Grant Publication No. 2003/0006878 A1.

18. As per Claim 23, Pauschinger et al; Pauschinger and Strand teach the system of claim 22 as described above. Pauschinger does not explicitly teach wherein the

identification tag includes a substrate fixed permanently to the print member. Strand teaches wherein the identification tag includes a substrate fixed permanently to the print member (see para. 12 lines 6-10, Examiner is interpreting a non-moveable tag located inside the housing of the cartridge as being permanent). Pauschinger nor Strand teaches a substrate fixed permanently to the exterior of the printer. Official Notice is taken that a substrate fixed permanently to the exterior of the printer is old and well known. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Pauschinger and Strand to include the teachings of Official Notice to allow external access to a substrate. Pauschinger does not explicitly teach an identification tag with communication means on the substrate. Chung teaches an identification tag with communication means on the substrate (see para. 96). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Pauschinger et al. and Pauschinger to include the teachings of Chung to tag and electronically identify objects as taught in Chung para. 96 lines 1-4.

19. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pauschinger et al. U.S. Patent No. 6,978,255 B1 in view of Pauschinger U.S. Patent No. 6,041,704 in further view of Strand U.S. Pre-Grant Publication No. 2002/0199094 A1 and Official Notice.

20. As per Claim 25, Pauschinger et al; Pauschinger and Strand teach the system of claim 22 as described above. Pauschinger does not explicitly teach wherein the data-generating unit includes an RF transceiver. Official Notice is taken that a data-

generating unit includes an RF transceiver is old and well known. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Pauschinger et; Pauschinger and Strand to include the teachings of Official Notice to facilitate communications with varied devices.

21. Claims 32-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pauschinger et al. U.S. Patent No. 6,978,255 B1 in view of Pauschinger U.S. Patent No. 6,041,704 in further view of Strand U.S. Pre-Grant Publication No. 2002/0199094 A1 and Beerling et al. U.S. Patent No. 6,325,488 B1.

22. As per Claims 32-33, Pauschinger et al. does not explicitly teach the limitation taught by Beerling, a printed circuit comprising PTF polymer (see Col. 1 lines 53-65 and Col. 2 lines 1-9). Pauschinger teaches a decrypting means. Strand teaches a substrate fixed to a print member. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Pauschinger et; Pauschinger and Strand to include the teachings of Beerling to ensure strength and thickness, as taught in Beerling, Col. 9.

23. As per Claims 34-41, Pauschinger et al. does not explicitly teach the limitation taught by Beerling, a printed circuit comprising PTF polymer that is approximately 0.125 mm thick; comprising a substrate and at least one circuit having a total thickness of less than 1.5 mm; from 1.5 mm through 2 mm (see Col. 9 lines 43-67). Pauschinger teaches a decrypting means. Strand teaches a substrate fixed to a print member. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to

modify the system of Pauschinger et; Pauschinger and Strand to include the teachings of Beerling to ensure strength and thickness, as taught in Beerling, Col. 9.

24. Claims 42-43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pauschinger et al. U.S. Patent No. 6,978,255 B1 in view of Pauschinger U.S. Patent No. 6,041,704 in further view of Strand U.S. Pre-Grant Publication No. 2002/0199094 A1 and Beerling et al. U.S. Patent No. 6,325,488 B1 and Official Notice.

25. As per Claims 42, Pauschinger et al. in view of Pauschinger and Strand teaches the system of claim 19 as described above. Pauschinger et al does not explicitly teach wherein the first communications mode utilizes a first communications channel; and the second communications mode uses a second communications channel. Official Notice is taken that the first communications mode utilizes a first communications channel; and the second communications mode uses a second communications channel is old and well known. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Pauschinger et; Pauschinger and Strand to include the teachings of Official Notice to facilitate communications with varied devices.

26. As per Claim 43, Pauschinger et al does not explicitly teach wherein the first communications channel is a wireless communications channel; and the second communications channel is a wired communications channel. Official Notice is taken that the first communications channel is a wireless communications channel; and the second communications channel is a wired communications channel is old and

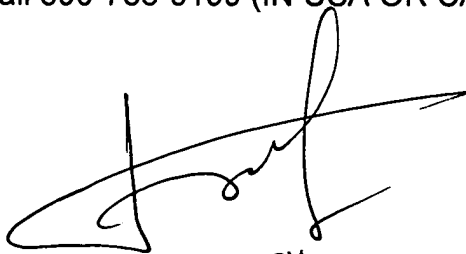
well known. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the to facilitate communications with varied devices.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tonya Joseph whose telephone number is 571-270-1361. The examiner can normally be reached on Mon-Fri 7:30am-5:00pm First Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571 272 0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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